



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/308,219	09/19/1994	MARC ALIZON	3495.001020	4832

22852 7590 12/05/2005

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER

FREDMAN, JEFFREY NORMAN

ART UNIT	PAPER NUMBER
----------	--------------

1637

DATE MAILED: 12/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 08/308,219	Applicant(s) ALIZON ET AL.	
	Examiner Jeffrey Fredman	Art Unit 1637	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-22,25 and 27-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17-22 is/are allowed.
- 6) ☒ Claim(s) 25,29,32 and 35-40 is/are rejected.
- 7) ☐ Claim(s) 27,28,30,31,33 and 34 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The rejection of claims 25, 29 and 32 under 35 U.S.C. 112, first paragraph, is withdrawn in view of Applicant's arguments and in view of the examiner's reconsideration that the generic claim complies with the requirements of 35 U.S.C. 112, first paragraph in this situation.

Claim Rejections - 35 USC § 112 – New Matter

2. Claims 35-40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As MPEP 2163.06 notes " If new matter is added to the claims, the examiner should reject the claims under 35 U.S.C. 112, first paragraph - written description requirement. In re Rasmussen , 650 F.2d 1212, 211 USPQ 323 (CCPA 1981)."

Here, the new limitation of the sequence "CTCAATAAAGCTTGCCTTG" in claims 35-40 is apparently new matter. The response does not point out any support for the new limitation to this specific sequence in the specification. A careful review by the examiner of the specification and drawings failed to identify any support for this new limitation.

Since no basis has been found to support the new claim limitation in the specification, the claim is rejected as incorporating new matter.

Double Patenting

3. Claims 25, 29 and 32 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6,627,395. Although the conflicting claims are not identical, they are not patentably distinct from each other because the issued claims represent a species which anticipates the current generic claims.

Claims 1-6 of U.S. Patent No. 6,627,395 teach a method for preparing and detecting HIV-1 RNA from a lysate of an HIV-1 virus, said method comprising: (a) providing a biological sample that comprises human CD4+ lymphocytes infected with HIV-1 virus; (b) separating said virus from said human CD4+ lymphocytes; (c) centrifuging said separated virus to form a fraction comprising concentrated virus; (d) isolating said fraction comprising concentrated virus; (e) lysing said virus; (f) precipitating the RNA of said virus; and (g) detecting said viral RNA.

2. The method of claim 1, wherein said method comprises banding said virus on a sucrose gradient or a metrizamide gradient.

3. The method of claim 1, wherein said method comprises pelleting said virus.

4. The method of claim 3, wherein said method comprises precipitating said virus with polyethylene glycol.

5. The method of claim 1, wherein the virus is lysed with SDS.

6. The method of claim 1, wherein said nucleic acid is precipitated with trichloroacetic acid.

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

Art Unit: 1637

unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Allowable Subject Matter

5. Claims 17-22 are allowed.
6. Claims 27, 28, 30, 31, 33 and 34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
7. The following is a statement of reasons for the indication of allowable subject matter: These sequences are novel and unobvious because the Chang patent expressly excludes a region of the sequence now claimed. The SstI fragment is absent from Chang and from Chang's clone, rendering Chang unable to anticipate or make obvious claims which encompass this SstI fragment region. Applicant correctly contends that these claims encompass that region and are therefore unobvious over Chang. Therefore, these claims are novel and unobvious.

Response to Arguments

8. Applicant's arguments filed October 25, 2005 have been fully considered but they are not persuasive.

Art Unit: 1637

Applicant argues that there is no new matter because there is support at page 13, line 13. That page is reproduced below

-13-

In this embodiment, the vector has the Tcau promoter from the T cell gene 10 promoter and eleven amino acids from the T cell gene 10 protein.

The vectors are then used to transform cells, such as E. coli. The T7 vector makes use of the T7 polymerase, which catalyzes RNA formation and recognizes only T7 promoter, which is the site where RNA polymerase binds for the initiation of transcription. This vector does not, however, recognize E. coli promoter. As a result, if HTLV-III DNA sequences are inserted after the promoter and polymerase genes of the T7 vector, which recognizes them to the exclusion of other signals, and a terminator is placed immediately after the HTLV-III DNA sequences, the T7 vector will direct manufacture RNA complementary to the HTLV-III DNA insert.

Monoclonal antibodies reactive with HTLV-III envelope polypeptide are produced by antibody-producing cell lines. The antibody-producing cell lines may be hybridoma cell lines commonly known as hybridomas. The hybrid cells are formed from the fusion of cells which produce antibody to HTLV-III envelope polypeptide and an immortalizing cell line, that is, a cell line which imparts long term tissue culture stability on the hybrid cell. In the formation of the hybrid cell lines, the first fusion partner - the antibody-producing cell - may be a spleen cell of an animal immunized against HTLV-III envelope polypeptide. Alternatively, the antibody-producing cell may be an anti-HTLV-III envelope polypeptide lymphocyte obtained from the spleen, peripheral blood, lymph nodes or other tissue. The

Nowhere in page 13 is support for the language found. Therefore, the new matter rejection is maintained.

The double patenting rejection is not traversed and is also maintained.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Fredman whose telephone number is (571)272-0742. The examiner can normally be reached on 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on (571)272-0782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1637

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffrey Fredman
Primary Examiner
Art Unit 1637

